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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/317,409      | 05/24/1999  | SCOTT D. LUCAS       | 1590.3039           | 9060             |

5514 7590 12/19/2001

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NEW YORK, NY 10112

EXAMINER

BEFUMO, JENNA LEIGH

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1771

DATE MAILED: 12/19/2001

17

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/317,409

Applicant(s)

LUCAS ET AL.

Examiner

Jenna-Leigh Befumo

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 October 2001.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12, 39-46, 55, 57-76 and 87 is/are pending in the application.
- 4a) Of the above claim(s) 1-12, 39-46, 60-76 and 87 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 55 and 57-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Amendment B, submitted as Paper No. 15 on October 25, 2001, has been entered. Claims 55 and 57 – 59 have been amended. Therefore, the pending claims are 1 – 12, 39 – 46, 55, 57 – 76, and 87. Claims 1 – 12, 39 – 46, 60 – 76, and 87 are withdrawn from consideration as being drawn to non-elected inventions.
2. Amendment A is sufficient to withdraw the objection to claim 57 – 59 set forth in section 5 of the previous Office Action.
3. Amendment A is sufficient to withdraw the 35 USC 102/103 to claim 55 over Corbett et al. (5,895,699) since Corbett et al. uses tiedown plies to prevent the prepreg layers from slipping during autoclave processing of the honeycomb structure.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claims 55 and 57 – 59 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Although, the disclosure does not specifically teach using tiedown plies with the present invention, no where in the disclosure does the Applicant teach that the invention is produced in the absence of tiedown plies. Although the invention can be made without, the specification does not require or disclose that the invention is made to the

Art Unit: 1771

exclusion of tiedown plies as claimed in claim 55. Further, it has been held that negative limitations recited in the claims, which did not appear in the specification as filed introduce new concepts and violate the description requirement of 35 USC 112. *Ex parte Grasselli*, 231 USPQ 393. Thus, the negative limitation in claim 55, reciting “the absence of a tiedown ply” is not supported by the disclosure.

Further, the disclosure does discuss tiedown plies as an example of mechanical or physical means which prevent differential movement between the prepreg layers (page 1, lines 35 – 38 and page 3, lines 25 – 29). Based on this definition of tiedown plies, and the teaching that the disclosure uses stiffened prepreg plies to prevent the differential slippage between the prepreg layers, the disclosed invention in fact requires a mechanical or physical means, or tiedown ply, i.e., the stiffness treated prepreg plies, to prevent slippage and thus prevent core crush. Thus, the disclosure does not teach or even suggest the absence of a layer which mechanically or physically prevents the slippage of the prepreg layers, since this is the basis of the Applicant’s invention. Therefore, the claimed invention is not enabled by the specification.

6. Claims 55 and 57 – 59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. The term “tiedown ply” in claim 55 is indefinite. Is a tiedown ply any type of material which mechanically or physically prevents the slippage of the prepreg layers in the honeycomb core lay-up. Or is a “tiedown ply” a specific type of layer which prevents the prepreg layers from slipping during autoclave processing, as suggested by the Corbett reference? Claims 57 – 59 are also rejected due to their dependency on claim 55.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Befumo whose telephone number is (703) 605-1170. The examiner can normally be reached on Monday - Friday (9:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Jenna-Leigh Befumo  
December 14, 2001



**CHERYL A. JUSKA  
PRIMARY EXAMINER**